

REMARKS:**Claims 1-4 and 6-25**

Claims 1-4 and 6-25 have been rejected under 35 USC 103(a) as being anticipated by Kawasaki et al. (US6765757) in view of Chang et al. (US6542331).

Applicants presume that the rejection is a 103/102(a) rejection.

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 1-4, 6-11, 13-22 and 24-25 prior to the effective date of Chang (April 1, 2003). Per MPEP 715.02, Applicants may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-4, 6-11, 13-22 and 24-25 based on Chang.

Regarding the limitations of claim 25, while not specifically shown in Exhibit A of the accompanying Declaration, are inherently present as evidenced by the Official Notice taken by the Examiner. Applicants note in Section 2 of the Office Action that the Examiner has taken Official Notice that structures such as that claimed in claims 1 and 15 are well known to be used for a magnetic storage system which includes magnetic media, a head, a slider for supporting the head, and a control unit for controlling operation of the head. Applicants concur that the design was intended for use in a magnetic storage system of a type having magnetic media, a head as shown in Exhibit A for reading and writing to the magnetic media, a slider for supporting the head, and a control unit for controlling operation of the head. Accordingly, the features of claim 25 are inherently disclosed in Exhibit A of the accompanying Declaration.

Regarding claims 12 and 23, as noted in the Office Action, neither Kawasaki nor Chang disclose forming a bump of cured resist. Rather, the rejection relies on obviousness and the fact that Chang discloses a cured resist process. Because the base invention was made prior to the effective data of Chang, and because the rejection is based on a modification of Kawasaki's structure as modified by Chang, Applicants

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believe that disqualification of Chang with respect to the core invention (parent claims 1 and 15) extends to the rejection of claims 12 and 23. Also, as the examiner will note in Exhibit A of the attached declaration, the disclosure of the present invention also discloses a cured resist process. Note the word "photo" adjacent several of the figures. Accordingly, under the logic of the rejection that it would have been obvious to modify a process implementing a cured resist process, Applicants' disclosure with a cured resist process predated the effective date of Chang. For either of these reasons, claims 12 and 23 are believed to be allowable over the art of record.

Claim 5

Claim 5 has been rejected under 35 USC 103(a) as being unpatentable over Kawasaki in view of Chang and in further view of Sato (US6683750).

The disqualification of Chang is believed to render claims 5 and 18 allowable.

103/102(e)

Regarding any of the aforementioned claims, if the rejection is based on a 103/102(e) rejection, Chang would also be disqualified for the following reasons.

Chang issued on April 1, 2003, after the earliest shown date of invention of the present invention (Oct. 14, 2002). Therefore, the rejection of the claims could be under 35 USC 103 is based on 35 USC 102(e) art. Applicants believe that Chang is disqualified as prior art to the present invention under 35 USC 103(c). Please find attached a statement signed by an attorney of record that Chang and the present application were both owned by and/or subject to an obligation of assignment to International Business Machines Corporation at the time of invention of the subject matter of the claimed invention in the present application. To support this assertion, a copy of the Patent Abstract of Title from the USPTO Assignments on the Web system showing Chang was assigned to International Business Machines Corporation as of April 2000 until Dec. 31, 2002. The Examiner is also invited to review the footer of Exhibit A of the attached Declaration, evidencing that the invention was subject to assignment to International Business Machines Corporation ("IBM").

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Applicants believe that the statement and the supplemental assignment information is sufficient to overcome any evidentiary requirement of the Examiner, particularly in light of the following quotes from MPEP 706.02(I)(2)(II):

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

...

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

Applicants believe that the disqualification of Chang would render all claims allowable over the references cited in a rejection based on 103/102(e).


In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner

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is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. HSJ920030069US1).

Respectfully submitted,

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